

REMARKS:

This amendment is for the purpose of amending the Specification in the original application by canceling claims 4, 14 and 20 and amending claims 1 - 2, 11 - 12 and 18 to overcome the rejections advanced by the Examiner in the instant office action. Applicants believe that these amendments to the claims put the application in condition for allowance and respectfully request reconsideration and allowance of claims 1 - 2, 5 - 12, 15, 17 - 18 .

The Official Action rejects claims 1 - 4, 6 - 7, 11 - 15, 18 and 20 under 35 U.S.C. 102(b) as being anticipated by Tsukioka, U. S. Patent 5,733,638. Specifically, the Examiner states that Tsukioka discloses a hot stamped material comprising a base and inner release layer which are laminated to the base for coating food wrapping materials where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate. The Examiner further states that Tsukioka discloses the sheet is rolled into a foil which includes a color layer and that the hot stamp material comprising a foil **transfers to the substrate by means of an adhesive** and that Tsukioka discloses that the substrate is embossed. Applicants have canceled claims 3 - 4, 13 - 14 and 20 without prejudice to Applicants' rights to file continuing applications on the matter contained therein therefore overcoming the rejection of claims 3 - 4, 13 - 14 and 20 thus overcoming the rejections of claims 3 - 4, 13 - 14 and 20 wherein the Examiner has equated the foil transfer adhesive of Tsukioka to the separate adhesive of Applicants' disclosure and wherein the Examiner has equated rolling of the foil of Tsukioka into a thin sheet to Applicants winding the laminated paper/hot transfer foil upon a roll for subsequent use. Applicants have also canceled claim 4 thus deleting any reference to a "substrate" as selectively applied from Tsukioka. The Examiner has stated that intended use or actual use of the product has little patentable weight, however, the Examiner has also repeatedly applied the use of Tsukioka in support of the rejection of Applicants' claims. The Examiner's attention is drawn to the brief description of Fig. 4 wherein Tsukioka declares that an image is "... deposited on a substrate such as food ..." and also to column 7 in line 36 wherein Tsukioka states that the release agent effectively wets "... the surface of an edible substrate when applied thereto." The Examiner's attention is further drawn to column 9 in line 49 wherein Tsukioka again repeats that the hot stamp material is "...

Straub, Docket 20003

5

15 August 2006

used to imprint a substrate such as food and other edible materials . . .” and in lines 56 - 60 wherein Tsukioka clearly states that the substrate is food, to wit, “An image of a character, pattern or design contained in the hot stamp, formed of gold or silver, is thus transferred to the substrate. The resulting hot-stamped image or imprint can thereafter be eaten together with the food.” Many other references to food as the substrate appear throughout the specification and claims of Tsukioka. Notwithstanding the repeated dichotomous rejection, in order to remove any confusion over intended use, Applicants have removed any reference to the intended use from the claims. Applicants have also amended claim 1 to recite that a **separate** planar wrapping paper has the hot transfer foil laminated thereto from a carrier carrying the hot transfer foil wherein the carrier is removed thus constituting a **intermediate** decorative paper wrapping film. Applicants have similarly amended claim 11 to recite that **separate** embossed wrapping paper has the hot transfer foil laminated thereto from a carrier carrying the hot transfer foil wherein the carrier is removed thus constituting a laminated embossed decorative wrapping paper and further amended claim 11 to recite that the decorative wrapping film has an exposed adhesive disposed on the side opposite the laminated hot inked foil, clearly outside the teachings of Tsukioka ~~as the~~ Examiner admits that Tsukioka **has adhesive only between the foil and the substrate and thus only** transfers the foil to the substrate by an adhesive whether on only one side or the both. Thus, no exposed adhesive can be present on either side of the substrate of Tsukioka as the adhesive is covered by the foil. The Examiner’s attention is drawn to Figures 5 through 20 of Tsukioka and the discussion thereof in col. 12 beginning at line 40 wherein Tsukioka discussed the adhesive layer Z1 attaching the pullalan film SO to the support T1, T2 or Y1 but clearly does not discuss, suggest, claim or show any adhesive on the side of the support opposite the adhesive layer Z1. Applicants, on the other hand, apply the adhesive to the side opposite the decorative layer and do not cover the adhesive with any decorative material. The Examiner’s attention is drawn to the specification on pages 5 - 8 in most of the objects of the invention, again on page 11 in line 9, on page 14 in line 28, on page 15 in line 27, on page 16 in line 26, on page 17 in lines 6 and 29, on page 19 in line 7 and on page 20 in line 21 wherein it is abundantly clear that Applicants apply

the adhesive to the side opposite the decorative surface. Applicants believe that significant structural differences have been established by amendments to the independent claims and further believe that these independent claims are not anticipated by Tsukioka. Antecedent basis for the terms "separate," "intermediate" or "another" as recited in the claims is found in the specification. Specifically, for the word "intermediate," the Examiner's attention is drawn to page 6 in lines 24 and 26, on page 22 in lines 26 and 29, on page 24 in lines 9, 11 and 17. For the word "separate" the Examiner's attention is drawn to page 12 in line 25 and for the word "another," the Examiner's attention is drawn to page 22 in lines 17 and 19. As Tsukioka does not teach either a intermediate, separate or another wrapping paper, whether planar or embossed, Applicants believe that the amendments to claim 1 and 11 overcome the rejections based upon 35 U.S.C. 102(b). Accordingly, Applicants respectfully request reconsideration and allowance of independent claims 1 and 11.

The Examiner continues the rejection by saying that Tsukioka further discloses that the sheet is rolled into a foil, which includes a color layer. Applicants have amended claims 11 - 12 and canceled claim 20 by deleting the reference to the process step of winding the completed product onto a roll and thus have overcome the rejection as the root word "roll" whether used as a verb, a noun, an adverb or an adjective is no longer contained in these claims. Additionally, Applicants have amended claim 18 by deleting the limiting word "colored" from the claim thus overcoming the rejection of claim 18 as the claim no longer contains any reference to color.

The Examiner additionally says that Tsukioka discloses the substrate is embossed in column 16, lines 20 - 25, however, a careful reading reveals that the "... image M1 can be transferred to the underlying substrate by various methods, ... including ... embossed by means of a hot stamp plate containing a pattern ..." which means that the substrate is not embossed but rather the image is an embossing upon the substrate. Applicants, on the other hand, in claim 11 and its dependent claims, provide an embossed wrapping paper to which the hot stamp foil is transferred to decorate the embossed surface with the particular features of the hot transfer foil with an adhesive exposed on the side opposite the hot transfer foil.

As stated above, Applicants have canceled claim 20 thus overcoming the

rejection thereof. As Applicants have canceled claims 3 - 4, 13 - 14 and 20 and amended claims 1 - 2, 11 - 12 and 18 as discussed above, Applicants believe that claims 1 and 11 and the dependent claims depending therefrom are in condition for allowance. Accordingly, Applicants respectfully request reconsideration and allowance of claims 1 - 2, 6 - 7, 11 - 13, 15 and 17 - 18.

The Official Action rejects claims 1 - 10 under 35 U.S.C. 102(b) as being anticipated by Phillips, et al., U. S. Patent 5,186,787. Specifically, the Examiner states in the verbatim comments supporting the rejection that Phillips discloses a hot stamp transfer imaged (inked) foil, carried on a releasable carrier, which is hot stamped onto a substrate, such as a paper or film (column 1, lines 8 - 25, 66 - 68 and column 2, lines 25 - 37, 47 - 64) where the composite is wound upon a roll (column 3, lines 20 - 21) and comprises a multilayer coating (column 3, lines 23 - 28). The transferred image on the coating(s) function as being translucent and opaque (column 4, lines 44 - 50) and an adhesive is placed on the back side of the foil (column 1, lines 22 - 23). Applicants have amended claim 1 by specifying that a hot stamp transfer foil, well known before the patent of Phillips, et al., is transferred to a separate planar wrapping paper thereby creating an intermediate paper decorative wrapping film clearly not taught by either Phillips, et al., or as discussed above by Tsukioka. Applicants have similarly amended claim 2 to recite that the separate planar wrapping paper of claim 1 which already has at least one hot transfer inked foil disposed thereupon from a carrier, has at least a second hot transfer inked foil carried on a carrier disposed upon the first layer(s) thereby creating an intermediate paper decorative wrapping film. It is clear from a reading of Phillips, et al., that no separate paper is used, no second hot transfer inked foil is applied to a first foil, no intermediate paper decorative wrapping film exists and that no intermediate paper decorative wrapping paper exists. In fact, a careful reading of Phillips, et al., will reveal that the paper alluded to by the Examiner in columns 1 in lines 8 - 25 is a **prior art hot stamp transfer foil**, the very hot stamp transfer foil Applicants apply to the separate planar wrapping paper to produce the intermediate paper decorative wrapping film as in claim 1 and the intermediate paper decorative wrapping film as in claim 2. The Examiner's attention is drawn to line 14 wherein the sentence starts "Heretofore . . ." thus clearly referring to prior art hot stamp transfer foils

which have also been clearly identified in Applicants' disclosure on page 5 in lines 3 - 6. Applicants believe that the above amendments to claims 1, 2 and cancellation of claims 3 - 4 place the application in condition for allowance & accordingly, Applicants respectfully request reconsideration and allowance of claims 1 - 10.

The Official Action rejects claims 11 - 15, 17 - 18 under 35 U.S.C. 103(a) as being unpatentable over Phillips, et al., U. S. Patent 5,186,787 in view of Boswell, U. S. patent 5,786,017. Applicants have amended claims 11 - 12 as recited above to set forth that the hot transfer foil is disposed on a separate embossed paper decorative film thus transforming the separate embossed film, canceled claims 13 and 14 without prejudice, have amended claim 18 by removing the offending word 'colored' thus overcoming the rejections thereof. In the rejection, the Examiner states that Boswell teaches a hot stamp transfer imaged foil, which is hot stamped onto a substrate, such as paper or film, which has adhesive on the back side of the film and an embossed image. The Examiner further states that Phillips, et al., and Boswell are directed to hot stamp transfer foils and that it would have been obvious to employ the embossed surface as taught in Boswell, in the decorative film of Phillips to improve the texture and appearance of the decorative film. Applicants believe that the amendments set forth above overcome the rejection. Applicants provide comment on the references as follows. A careful reading of Boswell reveals that the decorated surface is embossed **after** the structure is finished whereas Applicants apply a hot transfer foil to an already embossed surface. Thus, in Boswell, the entirety of the embossed portion has the characteristics of the layer B, which is a release coat, not a decoration, while in Applicants' disclosure the embossed surface receives the hot transfer foil only on the uppermost raised surfaces. Not only is the nature of the structure different, that is, the upper most layer is already embossed in Applicants' disclosure while it is embossed after completion in Boswell, the nature of the layers are also different as the uppermost layer is a release layer in Boswell and a decorative foil in Applicants' disclosure. Applicants have similarly amended claim 11 by reciting that a separate embossed wrapping paper receives the well known hot stamp transfer foil thereupon thus creating a laminated embossed wrapping paper also clearly not taught, discussed or claimed in Phillips, et al. It becomes abundantly clear that Phillips, et al., in

view of Boswell results only in an embossed release coat substituted for the printing layer of Phillips, et al., which Phillips, et al., effectively create with the optional printing. Therefore, Boswell provides nothing new to the body of art and as Phillips, et al., falls with respect to the independent claims, Phillips, et al., in view of Boswell falls also. Applicants believe that by canceling claims 13 - 14 and amending claims 11 - 12 and 18 as recited above, Applicants have put these claims along with those dependent thereupon in condition for allowance. Applicants respectfully request reconsideration and allowance of claims 11 - 12, 15 and 17 - 18.

Applicants are greatly appreciative of the Examiner's exhaustive search and studied consideration of the prior art in view of Applicants' disclosure and thus believe that the Examiner has found and considered the most pertinent art.

Applicants believe that by canceling claims 3 - 4, 13 - 14 and 20 and amending claims 1 - 2 and 11 - 12 to specifically recite that an intermediate decorative film exists after applying the hot transfer ink to the separate paper, Applicants have overcome the rejection of these claims based upon under 35 U.S.C. 102(b), and 35 U.S.C.103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 2, 5 - 12, 15 and 17 - 18 remain in this application and Applicants respectfully request reconsideration and allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

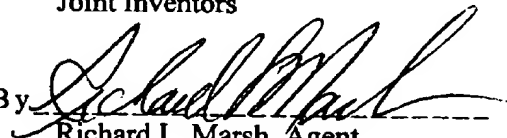
Respectfully submitted,

Herbert M. Straub, Martin D.

Straub and Timothy D. Ryan

Joint Inventors

By



Richard L. Marsh, Agent

Registration No. 31,637

4116 E. Latoka

Springfield, Missouri 65809

Date: 15 August 2006

Phone: (417) 887-8441 after 8:00 a.m. CST
(417) 838-3730 (cell)

Fax: (417) 887-8441 after 8:00 a.m. CST

Straub, Docket 20003

10

15 August 2006